

REMARKS

Claims 1-5 remain pending after entry of this amendment. Claims 1 and 2 were amended herein. Favorable reconsideration is respectfully requested in light of the amendments and remarks submitted herein.

Claims 1-5 are rejected under 35 U.S.C. § 112, first paragraph. Applicant respectfully traverses this rejection.

Claims 1-5 are rejected under 35 U.S.C. § 112, second paragraph. Applicant respectfully traverses this rejection.

Claims 1-5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 06-203848. Applicant respectfully traverses this rejection.

Rejection under 35 U.S.C. § 112, First paragraph

Claims 1-5 are rejected under 35 U.S.C. § 112, first paragraph, because the Examiner asserts that specification, while being enabling for a process that uses terpineol as the hydrophobic solvent, does not reasonably provide enablement for any hydrophobic solvent. The Examiner asserts that, based on page 3, there appears to be no evidence that solvents other than terpineol are operational in the claims. Applicant respectfully disagrees with the Examiner.

Applicant respectfully submits as a preliminary matter that a patent application is presumed enabled when filed, and that an Examiner has the initial burden to provide a reasonable basis to question the enablement. MPEP § 2164.04. Therefore, the Examiner's conclusory statement that "there appears to be no evidence that solvents other than terpineol are operational in the claimed invention" is an improper basis for a *prima facie* case of non-enablement. Furthermore, the Examiner did not appear to consider any of the Wands factors. Therefore, Applicant respectfully asserts that the Examiner has failed to establish a *prima facie* case of nonenablement, and also submits that the Examiner cannot make out a *prima facie* case.

The Wands factors include (1) the quantity of experimentation necessary; (2) the amount of direction or guidance presented; (3) the presence or absence of working examples; (4) the nature of the invention; (5) the state of the prior art; (6) the relative skill in the art; (7) the predictability of the art; and (8) the breadth of the claims. The Examiner has not specifically addressed any of these factors. Applicants address some of the factors below.

The quantity of experimentation necessary in this situation is low, it would merely require utilizing other hydrophobic solvents and forming the slurry. Such experimentation is merely routine and is certainly a reasonable amount.

The amount of direction or guidance presented is high. The specification generally provides that the solvent is hydrophobic (non-polar) (page 3, lines 21-22). The specification also mentions that commercially available thin-film diluents may be used (page 3, lines 16-17). An example of which is given as the commercially available thin-film diluent 8470 from Dupont (page 3, lines 17-18).

The specification does provide a working example that utilizes terpineol. Although the Examiner notes that there is no evidence to indicate that others would work, Applicants respectfully submit that the correct characterization of this, given the presumption of an enabled specification, is that there is no evidence that others wouldn't work.

The relative level of skill in the art is high, especially with respect to what is and what is not a hydrophobic solvent. One of skill in the art, would know, for example that the following are all hydrophobic solvents: all primary aliphatic alcohols with six or more carbon atoms, all secondary aliphatic alcohols with seven or more carbon atoms, all tertiary aliphatic alcohols with eight or more carbon atoms, and all tertiary cyclic aliphatic alcohols with seven or more carbon atoms. One of skill in the art would also know that there are also other solvents that are hydrophobic.

The predictability of the art, i.e., in determining whether a solvent is hydrophobic or not, is high. The hydrophobic nature of a solvent is something that one of skill in the art simply knows, there is no prediction involved.

Based on the Wands factors discussed above, Applicant respectfully submits that the invention is enabled throughout the scope of the claims. Applicant also points the Examiner to the section entitled **WORKING EXAMPLES AND A CLAIMED GENUS**, which can be found in MPEP § 2164.02. That section states that for a claimed genus, representative examples together with a statement applicable to the genus as a whole will ordinarily be sufficient if one skilled in the art would expect the claimed genus could be used in that manner without undue experimentation.

Applicant notes that the specification does include a working example and also includes a statement that hydrophobic solvents can be utilized. Applicant also notes that this section of the

MPEP also states that "proof of enablement will be required for other members of the claimed genus only where adequate reasons are advanced by the Examiner to establish that a person skilled in the art could not use the genus as a whole without undue experimentation." Applicant respectfully asserts that the Examiner has not provided any reasons why the genus as a whole would not work, and has only stated the conclusion that it will not work.

Based on the above arguments, Applicant respectfully asserts that the rejection of claims 1-5 under 35 U.S.C. § 112, first paragraph should be withdrawn.

#### Rejection under 35 U.S.C. § 112, Second paragraph

Claims 1-5 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner specifically points to claim 1, line 9, as containing the phrase "the solvents", which makes it appear as if more than one solvent is present. Claim 1 has been amended to clarify that there can be more than one solvent. Support of this amendment can be found at least at page 3, lines 18-20. Based on the above amendments and comments, Applicant respectfully requests that the rejection under 35 U.S.C. § 112, second paragraph be withdrawn.

#### Rejection under 35 U.S.C. § 103

Claims 1-5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 06-203848 ("'848"). The Examiner asserts, based on the abstract of JP 06-203848, that '848 teaches applying a paste of an ion exchange resin such as Nafion 117, a Pt catalyst and a solvent to form a slurry, applying the slurry to a substrate, removing the solvent by evaporation, and hot-pressing the material to form a layer of a fuel cell. The Examiner continues on to assert that the solvent appears to be hydrophobic, as it is applied to a hydrophobically treated substrate. Applicant respectfully disagrees with the Examiner's characterization of '848.

Applicant presents herewith a supplemental IDS that includes an English language translation of JP 06-203848. As seen in section [0010], on page 4, the solvent that is used in '848 includes aliphatic acids and water. Both aliphatic acids and water are hydrophilic solvents. Therefore, '848 does not teach or suggest all of the elements of the claims. Specifically, '848 does not teach the formation of a paste that does not contain any hydrophilic solvents.

Therefore, Applicant respectfully submits that '848 does not render the pending claims obvious, and requests that the rejection of claims 1-5 under 35 U.S.C. § 103 be withdrawn.

Conclusion

In view of the above amendments and remarks, Applicant respectfully requests a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

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